

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 3, 2003. Applicants appreciate the Examiner's consideration of the Application. Claims 1, 15, 23, 28, and 29 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. These amendments are not considered necessary for patentability. Applicants respectfully submit that no new matter has been added by the amendments to the claims. In order to advance prosecution of this Application, Applicants have responded to each notation by the Examiner. Applicants respectfully request reconsideration and favorable action in this case.

Section 112 Rejection

Claims 28 and 29 are amended in accordance with the requirement of the Examiner to correct informalities. Applicants thank the Examiner for pointing out the informalities. The claims particularly point out and distinctly claim the subject matter the Applicants regard as the invention, and thus are allowable under 35 U.S.C. § 112.

Section 103(a) Rejection

The Examiner rejects Claims 1-10 and 12-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,374,237 to Reese ("*Reese*") in light of U.S. Patent No. 6,341,304 to Engbersen et al. ("*Engbersen*"). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the *Reese-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants' claims. For example, *Reese-Engbersen* combination fails to disclose, teach, or suggest the following combination of elements (1a) – (1b) and (2a) – (2c) specifically recited in Applicants' claims:

(1a) a memory unit operable to "store information at the first station and to determine when to play the information"; and

(1b) a playback module operable to play information "in accordance with the determination of the memory unit " (recited in independent Claims 1 and 15, as amended); or

(2a) "storing information at the first station using the memory unit";

(2b) "determining at the memory unit when to play the information"; and

(2c) "playing the information using the playback module in accordance with the determination of the memory unit" (recited in independent Claim 23, as amended).

Reese discloses a "method and a system for requesting and retrieving information from distinct web network content sites." (*Reese*, column 1, lines 55-57). As acknowledged by the Examiner, *Reese* fails to teach a flow controller or a playback module. (Office Action, page 4, paragraph 1). *Reese* also fails to disclose, teach, or suggest a memory unit operable to store information at the first station and to determine when to play the information, as recited by independent Claims 1, 15, and 23.

Engbersen discloses a method and a system in which "network site and/or data requests are kept track of in terms of the number of times the same data or site request is presented." (*Engbersen*, column 1, lines 44-47). As acknowledged by the Examiner, *Engbersen* fails to teach a playback module. (Office Action, page 4, paragraph 2). Moreover, *Engbersen* fails to disclose, teach, or suggest a memory unit as recited by independent Claims 1, 15, and 23. *Engbersen* discloses:

In one example, when the request frequency for any particular data file reaches a predetermined number, or when a frequently requested data file is sufficiently large as to significantly impact the network bandwidth, the data file requested is marked for download during off-peak hours to a local non-volatile storage device such that subsequent user requests for that data item may be serviced directly from a local server or local storage device more proximate to the requesting user, thereby reducing overall bandwidth use for frequently requested data.

(*Engbersen*, column 1, lines 47-56). According to *Engbersen*, a data item is provided in response to a user request, so *Engbersen* fails to disclose, teach, or suggest a memory unit operable to "determine when to play the information" and a playback module operable to play information "in accordance with the determination of the memory unit," as recited by Claims 1 and 15, or "determining at the memory unit when to play the information" and "playing the information using the playback module in accordance with the determination of the memory unit," as recited by Claim 23.

Applicants respectfully traverse the Official Notice taken by the Examiner as to the rejection of these claims. Specifically, the Examiner takes Official Notice that "'a playback module for playing information stored at the station' in a computer network communication

environment was well know in the art at the time the invention was made." (Office Action, page 4, paragraph 3). Applicants respectfully disagree as to the playback module of the amended claims because a playback module that is operable to play information in accordance with the determination of a memory unit was not well know in the art at the time the invention was made. Moreover, the assertion regarding such a playback module is not capable of instant and unquestionable demonstration as being well-known. Accordingly, such an assertion is not appropriate. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." M.P.E.P. § 2144.03. Applicants request that the Examiner produce a reference in support of his position pursuant to M.P.E.P. § 2144.03.

Consequently, at a minimum, the *Reese-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements (1a) – (1b) and (2a) – (2c) as recited in amended independent Claims 1, 15, and 23. For at least these reasons, the *Reese-Engbersen* combination fails to disclose the elements specifically recited in Applicants' independent Claim 1.

Applicants' dependent claims are allowable based on their dependence on the independent claims and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicants believe they have amply demonstrated the allowability of the independent claims over the references of the rejection, and to avoid burdening the record, Applicants have not provided detailed remarks concerning these dependent claims. Applicants, however, remain ready to provide such remarks if it becomes appropriate to do so.

The Examiner rejects Claims 1-6, 11, 15, 16, 18-25, and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,249,576 to Sassin et al. ("*Sassin*") in light of *Engbersen*. Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the *Sassin-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements (1a) – (1b) and (2a) – (2c) as recited in independent Claims 1, 15, and 23. *Sassin* discloses "a method and system for providing telephone directory information." (*Sassin*, column 1, lines 6-7). As acknowledged by the Examiner, *Sassin* fails to teach a flow controller or a playback module. (Office Action,

page 6, paragraph 2-page 7, paragraph 1). *Sassin* also fails to disclose, teach, or suggest a memory unit operable to store information at the first station and to determine when to play the information, as recited by independent Claims 1, 15, and 23. As discussed above, *Engbersen* fails to disclose, teach, or suggest the memory unit as recited by independent Claims 1, 15, and 23. Accordingly, the *Sassin-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements (1a) – (1b) and (2a) – (2c) as recited in independent Claims 1, 15, and 23.

Applicants' dependent claims are allowable based on their dependence on the independent claims and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicants believe they have amply demonstrated the allowability of the independent claims over the references of the rejection, and to avoid burdening the record, Applicants have not provided additional detailed remarks concerning these dependent claims. Applicants, however, remain ready to provide such remarks if it becomes appropriate to do so.

The Examiner rejects Claims 1, 3, 11, 15, 16, 18-20, 22, and 25-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,256,620 to Jawahar et al. ("*Jawahar*") in light of *Engbersen*. Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the *Jawahar-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements (1a) – (1b) and (2a) – (2c) as recited in independent Claims 1, 15, and 23. *Jawahar* discloses "a system that monitors the access of information by an individual or system." (*Jawahar*, column 1, lines 6-8). As acknowledged by the Examiner, *Jawahar* fails to teach a flow controller or a playback module. (Office Action, page 8, paragraph 3-page 9, paragraph 1). *Jawahar* also fails to disclose, teach, or suggest a memory unit operable to store information at the first station and to determine when to play the information, as recited by independent Claims 1, 15, and 23. As discussed above, *Engbersen* fails to disclose, teach, or suggest the memory unit as recited by independent Claims 1, 15, and 23. Accordingly, the *Jawahar-Engbersen* combination suggested by the Examiner fails to disclose, teach, or suggest elements (1a) – (1b) and (2a) – (2c) as recited in independent Claims 1, 15, and 23.

Applicants' dependent claims are allowable based on their dependence on the independent claims and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicants believe they have amply demonstrated the allowability of the independent claims over the references of the rejection, and to avoid burdening the record, Applicants have not provided additional detailed remarks concerning these dependent claims. Applicants, however, remain ready to provide such remarks if it becomes appropriate to do so.

Accordingly, Applicants respectfully request reconsideration and allowance of independent Claims 1, 15, and 23 and all claims that depend on these claims.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicants, at the Examiner's convenience at (214) 953-6494.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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